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10/512,078	11/05/2004	Fabio Franceschi	023349-00298	3042
4372	7590	05/14/2009		
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER THAKUR, VIREN A	
			ART UNIT	PAPER NUMBER
			1794	
			NOTIFICATION DATE	DELIVERY MODE
			05/14/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
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Patent\_Mail@arentfox.com

**Office Action Summary****Application No.**

10/512,078

**Applicant(s)**

FRANCESCHI, FABIO

**Examiner**

VIREN THAKUR

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-13, 15-23 is/are rejected.
- 7) ☒ Claim(s) 15-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 1, 2009 has been entered.

***Response to Amendment***

2. The previous objection to claims 14-16 as being dependent on cancelled claims 5 and 6 has been withdrawn.

3. As a result of the amendment to the claims, the rejection of claims 1, 2, 3, 7 and 14-16 under 35 U.S.C. 102(b) as being anticipated by Favre (CH 688686) has been withdrawn.

***Claim Objections***

4. Applicant is advised that should claim 15 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both

cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 1-4, 7-13, 15-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Claim 1 recites the limitation "the flexible first container comprises a self-contained and fully enclosed pod made of filter paper ... placed inside the first container." Claim 22 recites the limitation "wherein the powdered infusion substance is retained in a self-contained and fully enclosed filter membrane pod that is contained within the first container..." Claim 23 recites "the flexible first container retains therein a self-contained and fully enclosed pod made of filter paper." Regarding these three limitations, it is noted that applicant appears to claim that the first container and the pod comprised of filter material, which completely encloses the infusion substance, are two different entities, since the pod is contained within the first container. Applicant does

not have support for this limitation in the specification and thus is new matter. The specification indicates on page 1, lines 13-19 that "a pod is a single measure of coffee or other infusion product enclosed in a sealed filter paper container or bag..." On page 3, lines 31-36, applicant's specification discloses that "the capsule 1 also comprises a container or pod 6 of filter paper or similar filter material, containing a tablet of infusion material M1...and positioned at the top 7 of the cartridge 2." This appears to indicate that the pod and container are one in the same and therefore applicant does not have support for the pod being placed into a separate first container.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-4,7-13,15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is noted that claim 1 recites that the first container "comprises a self-contained and fully enclosed pod made of filter paper or other similar filter material placed inside the first container." This limitation is not clear as to how the pod can be placed within the first container, when the first container comprises the pod.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claims 1-2, 7, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Favre (CH 688686) in view of Cavalluzzi (US 3985069), Moerlini et al. (US 3411431), le Granse (US 4550024), Ranz (US 2615384), and van der Lijn et al. (US 4860645).**

Regarding claim 1, Favre discloses a capsule (figure 2a) used to prepare an infused beverage such as coffee/espresso (see 2nd paragraph of the translation), comprising a first container (figure 2a, item 71) containing a substance to be extracted or dissolved separate from the product contained in the main compartment (7). The product in the main compartment is to be dissolved. It is noted that Favre discloses wherein the first container (71) comprises a side made from a membrane comprising holes (see column 3, lines 31-39) which are further comprised of a mixture of fibers (see column 3, line 63 to column 4, line 18). Favre further discloses a second container

(figure 2a item 1) attached to the first container. Regarding the limitation of the first container made of a "substantially flexible material, it is noted that since the filter (42) which comprises the pod is made of a filter material, that it inherently is considered "substantially flexible." The second container is a cartridge and is made from either aluminum or plastic (column 2, lines 12-19 and column 4, lines 26-31) and therefore is considered "substantially rigid." It is noted that in both cases, the terms "substantially rigid" and "substantially flexible" do not provide specificity as to what would be considered rigid and what would be considered flexible, since the specification does not define these phrases either. Favre further discloses a top of the capsule covered by a removable sheet of protective material (figure 2a, item 41).

Claim 1 newly recites the limitation that the first flexible container comprises a self contained and fully enclosed pod, made of filter paper or other similar filter material placed inside the first container, and wherein the filter paper or filter material of the pod contains the powdered infusion substance therein after the removable sheet has been removed.

Favre already teaches placing an infusion material within container (71) and a soluble/dissolvable material in the second container (7) and also teaches a removable cover (41) that covers the top of the capsule but is silent in the first container (71) being comprised of a self-contained and fully enclosed pod made of filter paper or other similar filter material.

Cavalluzzi has been relied on to teach the advantages of providing a fully enclosed container for containing the infusible/extractable substance such as ground

coffee for the purpose of preventing the upward migration of coffee during the brewing stages (column 6, lines 4-9).

To therefore modify Favre and completely enclose the extractable substance in a filter material container would therefore have been obvious to one having ordinary skill in the art, for the purpose of preventing the upward migration of coffee during the brewing stages.

It is further noted that Moerlini et al. has been relied on as further evidence that it was a conventional concept in the art to provide a pre-made pod comprised of filter paper, which is then placed into a container/cartridge that is then used for extracting the contents from the filter paper pod (column 2, lines 41-61 and figure 4). Le Granse has been cited as further evidence that a fully enclosed container made of filter paper (figure 1, items 3 and 4) which is subsequently inserted into a second container for the purpose of extracting the contents therein, has been a conventional expedient for providing an extractable substance within a cartridge. Ranz (figure 5) has been cited as further evidence of a fully enclosed pod comprising an extractable substance, as is van der Lijn et al. (figure 9 and column 3, lines 51-59). The references to Moerlini et al., Le Granse, Ranz and van der Lijn et al. provide further evidence that it has been conventional in the art to employ fully enclosed pods comprising filter paper and an extractable substance contained therein, which are then placed into a second container, (see le Granse, Moerlini et al. and van der Lijn et al.) for the purpose of extracting the contents. To therefore modify Favre and employ another conventional expedient for providing an



extractable substance would therefore also have been an obvious matter of choice and/or design routinely determinable by experimentation.

Regarding claim 2, Favre teaches that the first container is heat sealed to the top of the cartridge (50) (see column 3, lines 31-39).

Regarding claims 7 and 15-16, Favre teaches that the second container can be made from plastic, as discussed above. Although not specifically reciting that the plastic is food safe, since the cartridge is used to hold food products, it would have been obvious to one having ordinary skill in the art to make the cartridge out of a food safe material, for the purpose of ensuring that the packaging does not contaminate the food.

**12. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1-2, 7, 15-16, above, and in further view of Brody (The Encyclopedia of Food Packaging Technology).**

Claims 3 and 4 differ from the previously applied combination of references in reciting that the first container is attached to the second container by gluing (claim 3) or ultrasound sealing (claim 4).

It is noted the particular recited method by which the first container was fixed to the second container has been a conventional method for adhering one item to another. In any case, with respect to ultrasound sealing, it is noted that Brody teaches that it has been conventional in the art to use ultrasonic sealing for its art recognized and applicants' intended purpose. Regarding gluing, it is noted that by heat sealing, Favre is in essence gluing the first container to the second container, since as a result of heat

sealing the melted material acts like a glue to thus create the seal. It is further noted, however, that once it was taught to employ a conventional sealing technique such as heat sealing to therefore substitute one conventional sealing method for another conventional sealing method would have been an obvious matter of choice and/or design for the purpose of achieving the desired sealing properties between the two containers.

**13. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1-2, 7, 15-16, above and in further view of of Arkins et al. (US 6116782), Lagneaux (EP 0007876) and Cai (US 20020078831) and as further evidenced by Robichaud et al. (US 5782404).**

Regarding claim 8, Favre discloses wherein the bottom surface of the cartridge is pierced, as shown in figure 6. Therefore, Favre teaches that it has been conventional in the art to pierce a portion of the cartridge for the purpose of releasing the beverage.

The claim differs from Favre in specifically reciting wherein the bottom surface of the cartridge has a hole in it, covered by a seal which is designed to be pierced or removed.

Arkins et al. teaches that it was conventional in the art to apply an area of weakness over a hole, for facilitating piercing of the container and providing access to the contents within the container (see abstract). Lagneaux teaches openings in the bottom of the cartridge (figure 1, item 20), which are sealed (figure 1, item 16) and that are also pierced. Cai also teaches providing an area of weakness over a hole within the

cartridge, which is broken and thus releases the liquid contained therein (paragraph 0045 and 0049). Robichaud et al. has been relied on to teach that it was conventional in the art to employ a frangible material over a hole for the purpose of facilitating breaking of the material in order to release the contents therein (See figure 4). To therefore modify Favre and employ a hole which is then sealed with a frangible material would therefore have been obvious for its art recognized and applicant's intended function of facilitating piercing of the container. For instance, the frangible seal, in covering the hole, also maintains the contents sealed within the container.

Regarding claim 9, it is noted that Cai already teaches wherein the seal constitutes a portion of the bottom surface of the cartridge, so that the seal breaks away and releases the contents within the cartridge (Paragraph 0049 and figure 7a, for instance). Since Favre already pierce the bottom of the cartridge, to modify Favre and use a seal which constitutes a bottom surface of the cartridge, for the purpose of facilitating piercing of the cartridge, would have been obvious in view of the art taken as a whole.

**14. Claims 10-11 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 8-9 above, and in further view of Kataoka (US 20020148772 A1), Harriss (US 2965501), Bernhardt (US 4340138) and Petrofsky et al. (US 5045333).**

Regarding claim 10, the combination as applied to claim 1, teaches a rigid second container made of a food safe plastic material and a first container comprising a

pod made of a filter material that fully encloses the infusible material. The references to Arkins et al. and Cai '831 have been relied on to teach a seal constituting the bottom surface of the cartridge, as discussed above with respect to claims 8 and 9.

Regarding the matching of the annular outer edge of the filter paper pod being fixed to a matching annular protuberance on the plastic cartridge, it is noted that the Favre already teaches that the filter paper container is secured to a matching protuberance on the second container, as shown in figure 2a. It is noted that Kataoka (Figure 3, item 10), Harriss (Figure 3), Bernhardt (Figures 1 and 3) and Petrofsky et al. (Figure 2), all teach that it was a conventional expedient in the art to mate an annular edge with an annular protuberance for the purpose of securing a first smaller container into a second larger container. To therefore modify the combination, if even necessary, and employ a conventional mating structure, as taught by the art taken as a whole, would have been obvious to one having ordinary skill in the art for the purpose of securing a first container within a second container.

Regarding claim 11, Favre disclose wherein the protective cover material is removably placed over the top of the filter paper pod and mates with the annular protuberances of the cartridge, as shown in figure 2b.

Claims 17-20 are rejected for the reasons given above with respect to claim 10.

Claim 21 is rejected for the reasons given above with respect to claim 10.

Claim 22 is rejected for the reasons given above with respect to claim 1 regarding the first flexible container and a fully enclosing pod comprising an infusible material and claims 8-9 with respect to the covered seal.

Claim 23 is rejected for the reasons give above with respect to claim 1 regarding a first flexible container and a fully enclosing pod comprising an infusible material; with respect to claim 10 regarding the filter paper comprising an annular outer edge and the container having a matching annular protuberance.

**15. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1-2,7,15-16, above, and in further view of Cai (US 6777007).**

Regarding claim 12, it is noted that Favre teaches making coffee and espresso drinks and wherein the substance in the first container is an extractable substance, while the substance in the second container is a soluble substance. The claim differs from Favre in specifically reciting wherein the material in the first container comprises powdered coffee.

It is noted, as evidenced by Cai '007 in figure 11, for instance, item 33 is powdered milk and item 33a is ground (or powdered) coffee (also see column 9, line 61 to column 10, line 10). By putting the coffee grounds on top of the powdered milk, Cai '007 teaches preventing clogging of the filter paper (column 10, lines 6-10). To therefore modify the combination and employ coffee grounds in the first compartment and powdered milk in the second would have been obvious for the purpose of preventing clogging of the filter.

***Response to Arguments***

16. Applicant's arguments filed April 1, 2009 and the arguments submitted with the after final amendment, filed February 4, 2009 have been fully considered but are moot in view of the new grounds of rejection necessitated by the amendment to the claims.

Applicant's arguments were based on Favre failing to teach that the first container was an enclosed pod. It is noted that the references, as applied above, have been relied on to teach that it was conventional and even advantageous to enclose the infusible material within a pod.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 211511 A discloses a cartridge that employs a stepped surface to secure the cartridge to a second container. (Figure 4). US 20020035928 A1 discloses a first container comprising an infusible material which is then placed into a second container. US 4859337 A discloses a first filter material comprising an infusible material which is then placed into a second container. US 4921712 A discloses an enclosed pod comprising an infusible material (figure 1B). US 5840189 A discloses a filter paper chamber comprising an infusible material which is placed into a second container. FR1198879 discloses a first container nested into a second container (figure 8) for making a beverage from an infusible material.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/  
Primary Examiner, Art Unit 1794

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